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EXAMINER
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DANIEL JR, WILLIE J

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.	Applicant(s)	
09/919,391	FITZPATRICK ET AL.	
Examiner	Art Unit	
Willie J. Daniel, Jr.	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This action is in response to applicant's amendment filed on 31 October 2006. **Claims 1-20** are now pending in the present application. This office action is made **Final**.

### *Response to Amendment*

2. The declaration(s) filed on 31 October 2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Wang et al. (US 6,934,543 B2) reference.
3. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Wang et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

Regarding applicant's remark on pg. 8, line(s) 9-10 (also, see declarations items 4 and 6), "...declarations establish conception...prior to the effective date of Wang...", the Examiner respectfully disagrees. For example, the declarations (hereinafter **Document A**) nor the submitted IBM invention disclosure form (hereinafter **Document B**) disclose of the following:

- a. Documents A and B failed to provide a distinction between voice call (e.g., telephone call as recited in claim 16) and **non-voice call** (e.g., mobile message as recited in claims 1, 6, 8-9, 12, and 14-15). Furthermore, Document B, section main idea only states "...caller wishing to talk..." as indicated in items 1-3 and more particularly in

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scenario 1-2. In addition, see the instant application as originally filed on pg. 11, lines 14-18 which clearly recites the language "...the call can be a voice call, the call can also be a **data call**..." and said language is clearly not supported in the Document B.

- b. Documents A and B failed to provide "...local information...comprises...**date**..." as recited in claim 2, line 3 as well as in claims 5, 10, 13, and 17-18 also includes in a similar feature. Document B, section main idea only states "...current location and timezone..." in item 1, line 6. Also, Document B, section main idea only states "...local time...day-of-week...local holiday information..." in items 2 and 3. In addition, see the instant application as originally filed on pg. 9, lines 14-21 which clearly recites language of local information such as "...April 26..." and said language is clearly not supported in the Document B.

At the least and as a result of **items 3a and 3b** above, the complete claimed invention was not conceived prior to the date of the Wang et al. reference. There is clearly no support for the claim language indicated in the examples of items 3a and 3b above. The Examiner agrees that Document B is a summary in nature, nonetheless, the concepts summarized in the Document B and the facts stated in the Document A must be supported by full documentary evidence and exhibits (e.g., notes, drawings, sketches, drafts, or the like) in support thereof. The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere

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pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). See MPEP § 715.07(I).

Consequently, the evidence (including Documents A and B) is insufficient to establish conception of the complete claimed invention prior to the effective date of the Wang et al. reference.

4. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Wang et al. reference to either a constructive reduction to practice or an actual reduction to practice.

Regarding applicant’s remark on pg. 9, 3<sup>rd</sup> ¶ (also, see Document A, items 4 and 6), “...exercised due diligence from prior to the effective date of Wang...from at least December 1, 2000, through the filing of the application...”, the Examiner respectfully disagrees. Applicant has clearly not provided any documentation that represents due diligence prior to the filing of Wang et al. reference.

MPEP states an applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959). Diligence requires that applicants must be

specific as to **dates and facts**. The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958); *Griffith v. Kanamaru*, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987). See MPEP § 2138.06.

Therefore, since the applicant did not show diligence from alleged conception to a constructive reduction of practice, the evidence (including Documents A and B) is insufficient to overcome the Wang et al.

5. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Wang et al. reference.

Regarding applicant's remark on pg. 8, 1<sup>st</sup> ¶, lines 7-8 (also, see pg. 9, 3<sup>rd</sup> ¶), "...actively pursued its reduction to practice from a date prior to the effective date of Wang...", the Examiner respectfully disagrees. Applicant has clearly not provided any documentation or evidence that represents reduction to practice nor was any such substantial language stated in Document A.

6. In response to applicant's remark on pg. 8, 2<sup>nd</sup> ¶, (also, see Document A, item 4), "...**No modifications** were subsequently made...", the Examiner respectfully disagrees. The claimed invention includes at the least further modifications described in **items 3a and 3b** above, which **were not** included Document B. Applicant has clearly failed to provide evidence proving conception, diligence, and reduction to practice.

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7. The statements provided above are not the only but a few reasons to deny the evidence (including Documents A and B) submitted. Therefore, as indicated above, the Wang et al. reference is maintained and considered as applicable prior art.
8. This list of examples is not intended to be exhaustive.

### *Claim Objections*

9. **Claims 8-9** are objected to because of the following informalities:
  - a. **Claim 8** omitted to include a mark-up limitation “...~~local~~...” in line(s) 5 of the claim. The limitation was included in the response filed on 18 January 2006. The Examiner interprets as though the applicant intended to exclude the limitation. See MPEP § 714 and 37 CFR 1.121(c).
  - b. **Claim 9** includes a mark-up limitation such as “...~~originating source~~...” as recited in line(s) 9 of the claim, which is amended language from the response filed on 18 January 2006. The Examiner interprets as though the applicant intended to exclude the limitation and suggests removing the limitation from the claim. See MPEP § 714 and 37 CFR 1.121(c).

Appropriate correction is required.

10. This list of example(s) is not intended to be exhaustive.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claim 16** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention:

- a. **Claim 16** recites the limitation "...**automatically** determining whether to complete said telephone call..." in lines 9-10 of the claim. The applicant on pg. 4, 4<sup>th</sup> ¶ of remarks section states, "...p. 3, line 10 - p. 4, line 7; and p. 9, lines 9-21..." as support for the claimed limitation. The cited area does not mention "...**automatically** determining whether to complete said telephone call ...". The applicant is advised to review the subject matter of the specification (see pg. 6, lines 7-13; pg. 9, lines 11-13; pg. 10, lines 5-11), which clearly states the originating party determines that a call is to be connected.
- b. **Claim 16** recites the limitation "...said alert signal **identifying** said calling party..." in lines 14-15 of the claim. The applicant on pg. 4, 4<sup>th</sup> ¶ of remarks section states, "...p. 3, line 10 - p. 4, line 7; and p. 9, lines 9-21..." (also, see pg. 9, 3<sup>rd</sup> ¶) as support for the claimed limitation. The cited area does not mention "...said alert signal **identifying** said calling party...". The applicant is advised to review the subject



matter of the specification (see pg. 6, lines 5-8; pg. 10, lines 8-9), which clearly states the alert signal is a ring tone.

Regarding **claim 16**, the claims include limitations that are not supported by the specification as originally filed. The Examiner respectfully requests the applicant to provide page(s), line(s), and figure(s) of the instant application that supports the limitation of the claim(s) and/or any supportive comment(s) to help clarify and resolve this issue(s).

12. In response to applicant's remark of claim 16 on pg. 7, 3<sup>rd</sup> ¶, "...fully supported...different portion...Fig. 2 and specification, pg. 10, ln. 12-21 and pg. 11, ln. 1-13...", the Examiner respectfully disagrees. As cited by applicant, Fig. 2 "ref. 225" clearly indicates that the originating PCD (105) selects an action (225) of a provided prompt (220). Therefore, as addressed in **item 11a** above, the claimed limitation "...**automatically**..." is clearly described as a manual selection (225) of a provided prompt (220).
13. In response to applicant's remark of claim 16 on pg. 7, 3<sup>rd</sup> ¶, "...fully supported...different portion...Fig. 2 and specification, pg. 10, ln. 12-21 and pg. 11, ln. 1-13...", the Examiner respectfully disagrees. As cited by applicant, Fig. 2 "ref. 230" clearly indicates that an alert if urgent (230) is provided via the service provider (135) in which the alert signal is a **ringtone** (see pg. 11, lines 5-8). Therefore, as addressed in **item 11b** above, the claimed limitation "...**identifying** said calling party..." is clearly described as a ringtone **not** an identification of calling party (or caller ID).
14. This list of examples is not intended to be exhaustive. The Examiner respectfully requests the applicant to review all claims and clarify the issues as listed above as well as any other issue(s) that are not listed.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-2, 4-5, 7-10, 12-13, 15-18, and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rignell et al.** (hereinafter Rignell) (**US 5,818,920**) in view of **Wang et al.** (hereinafter Wang) (**US 6,934,543 B2**).

Regarding **claim 1**, Rignell discloses a method for providing call which reads on the claimed “message” recipient local information (see abstract; col. 3, lines 28-50; Figs. 1-3) comprising the steps of:

identifying an attempt to send a mobile call which reads on the claimed “mobile message” from a sending party (e.g., subscriber A) to a receiving handheld terminal (C) which reads on the claimed “device” of a receiving party (e.g., subscriber C) (see col. 5; lines 5-21);

responsive to said identifying step, determining information local to said receiving party (C) (see col. 5, lines 15-19; Fig. 3), where the local information is the time and time zone of the receiving handheld device,

wherein said location information indicates whether said receiving party (C) is not to be disturbed (see col. 7, lines 15-18,21-25; col. 8, lines 5-8,16-20), where the message for subscriber (C) indicates a filter is active in which the “not to be disturbed” would be inherent

to provide restriction of a call during a certain time range as evidenced by the fact that one of ordinary skill in the art would clearly recognized;

providing said determined local information to said sending party (A) (see col. 5, lines 15-19; col. 4, lines 60-64; col. 2, lines 28-31; col. 6, lines 64-67; Figs. 1-4), where the calling subscriber (A) receives local information (e.g., time zone and local time) of receiving party (C). Rignell does not specifically disclose having the feature sending an alert signal to said receiving handheld device if the message is indicated as urgent by the sending party.

However, the examiner maintains that the feature sending an alert signal to said receiving handheld device if the message is indicated as urgent by the sending party was well known in the art, as taught by Wang.

In the same field of endeavor, Wang discloses the feature sending an alert signal (e.g., call) to said receiving handheld device (MS B) if the message is indicated as urgent by the sending party (MS A) (see col. 3, lines 38-49; Fig. 2 “ref. 207-210”), where the emergency call is connected to mobile subscriber unit (B). As a note, Wang further discloses the feature wherein said location information indicates whether said receiving party is not to be disturbed (e.g., inconvenient) (see col. 3, lines 34-38; Figs. 2 “ref. 206” and 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell and Wang to have the feature sending an alert signal to said receiving handheld device if the message is indicated as urgent by the sending party, in order to filter incoming call, such that mobile calls are not established during a time which is inconvenient for the called mobile subscriber unless the call is an emergency call, as taught by Wang (see col. 1, lines 22-25, 28-29).

Regarding **claim 2**, the combination of Rignell and Wang discloses every limitation claimed, as applied above (see claim 1), in addition Rignell further discloses the method according to claim 1, wherein said local information further comprises information selected from the group consisting of a time, date, and day where said receiving handheld device (C) is located (see col. 5, lines 15-19; col. 4, lines 60-64; Figs. 1-4), where the local information is the local time of day and the time zone that the receiving handheld device is located.

Regarding **claim 4**, Rignell discloses a method for providing message recipient local information (see abstract; col. 7, lines 6-25; Figs. 2-3) comprising the steps of:

initiating a mobile message (call) between a sending party (A) and a receiving handheld device (B) of a receiving party (e.g., subscriber B) (see col. 7, lines 6-25; Fig. 3);

receiving local information from a service provider which services said receiving handheld device (B) (see col. 7, lines 15-18; col. 4, lines 60-64; Fig. 3), where the local information is provided in which the “service provider” would be inherent to provide call communication between subscriber A and B via communication system (10) as evidenced by the fact that one of ordinary skill in the art would clearly recognized,

wherein said location information indicates whether said receiving party (B) is not to be disturbed (see col. 7, lines 15-18,21-25; col. 8, lines 5-8,16-20), where the message for subscriber (B) indicates a filter is active in which the “not to be disturbed” would be inherent to provide restriction of a call during a certain time range as evidenced by the fact that one of ordinary skill in the art would clearly recognized;

processing said mobile message (call) based on said received local information (see col. 7, lines 15-25; col. 2, lines 28-31; col. 6, lines 64-67; Figs. 1-4), where the call would be

processed by the calling subscriber according to the local information of the called subscriber. Rignell does not specifically disclose having the feature sending an alert signal to said receiving handheld device if the message is indicated as urgent by the sending party. However, the examiner maintains that the feature sending an alert signal to said receiving handheld device if the message is indicated as urgent by the sending party was well known in the art, as taught by Wang.

In the same field of endeavor, Wang discloses the feature sending an alert signal (e.g., call) to said receiving handheld device (MS B) if the message is indicated as urgent by the sending party (MS A) (see col. 3, lines 38-49; Fig. 2 “ref. 207-210”), where the emergency call is connected to mobile subscriber unit (B). As a note, Wang further discloses the feature wherein said location information indicates whether said receiving party is not to be disturbed (e.g., inconvenient) (see col. 3, lines 34-38; Figs. 2 “ref. 206” and 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell and Wang to have the feature sending an alert signal to said receiving handheld device if the message is indicated as urgent by the sending party, in order to filter incoming call, such that mobile calls are not established during a time which is inconvenient for the called mobile subscriber unless the call is an emergency call, as taught by Wang (see col. 1, lines 22-25, 28-29).

Regarding **claim 5**, the combination of Rignell and Wang discloses every limitation claimed, as applied above (see claim 4), in addition Rignell further discloses the method according to claim 4, wherein said local information further comprises information selected from the group consisting of a time, date, and day where said receiving handheld device (B)

is located (see col. 7, lines 15-18; col. 5, lines 15-19; col. 4, lines 60-64; Figs. 1-4), where the local information is the local time of day and the time zone that the receiving handheld device is located.

Regarding **claim 7**, the combination of Rignell and Wang discloses every limitation claimed, as applied above (see claim 4), in addition Rignell further discloses the method according to 4, wherein said processing step comprises, selecting an action from the group of actions consisting of connect which reads on the claimed “sending” said mobile message (call) to said receiving handheld device (B), sending said mobile message (call) to a mail box (e.g., answering machine), and not sending said mobile message (call) (see col. 7, line 18-25; col. 8, lines 23-25; Fig. 3), where the calling subscriber can confirm the call by deciding to connect or terminate or be connected to an answering machine or answering service.

Regarding **claim 8**, Rignell discloses a system for providing location-based recipient information (see abstract; col. 3, lines 28-50; col. 5, lines 5-21; col. 6, line 60 - col. 7, line 25; Figs. 1-4) comprising:

- a wireless service provider for providing wireless telephony services to a network of handheld devices (see col. 6, line 60 - col. 7, line 25; Fig. 3);

- a notification system configured to provide call recipient information associated with a receiving party in response to an attempt to send a mobile message (call) from a first handheld device associated with a sending party to a second handheld device associated with said a receiving party in said network, said call recipient information comprising local information acquired from a time source and receiving party information (see col. 6, line 60 - col. 7, line 5; col. 7, lines 11-15; col. 8, lines 45-47), where the base station, the base station

controller, real-time clock, or PSTN is the source that provides the local time as evidenced by the fact that one of ordinary skill in the art would clearly recognize,

said receiving party information indicating whether said receiving party (B) is not to be disturbed (see col. 7, lines 15-18,21-25; col. 8, lines 5-8,16-20), where the message for subscriber (B) indicates a filter is active in which the “not to be disturbed” would be inherent to provide restriction of a call during a certain time range as evidenced by the fact that one of ordinary skill in the art would clearly recognized,

wherein said notification system being further configured to acquire said local information prior to sending said mobile message (call) (see col. 6, line 60 - col. 7, line 5; col. 7, lines 11-15; col. 8, lines 45-47), where the base station, the base station controller, real-time clock, or PSTN is the source that provides the local time,

wherein said notification system being yet further configured to delay sending said mobile message (call) until a decision to affirmatively send said mobile message (call) is made by said sending party (A) based on said provided call recipient information (see col. 7, lines 6-25; col. 5, lines 15-19; col. 4, lines 60-64; col. 2, lines 28-31; col. 6, lines 64-67; Fig. 3), where the local information is provided prior to connecting (sending) the call in which the system waits until the subscriber confirms to connection (sending). Rignell does not specifically disclose having the feature wherein said notification system being still further configured to send an alert signal to said receiving handheld device if the message is indicated as urgent by the sending party. However, the examiner maintains that the feature wherein said notification system being still further configured to send an alert signal to said

receiving handheld device if the message is indicated as urgent by the sending party was well known in the art, as taught by Wang.

In the same field of endeavor, Wang discloses the feature wherein said notification system being still further configured to send an alert signal (e.g., call) to said receiving handheld device (MS B) if the message is indicated as urgent by the sending party (MS A) (see col. 3, lines 38-49; Fig. 2 “ref. 207-210”), where the emergency call is connected to mobile subscriber unit (B). As a note, Wang further discloses the features said call recipient information comprising local information acquired from a time source and receiving party information (see col. 3, lines 60-63; col. 5, lines 56-65; col. 6, lines 4-18; Figs. 8-9) and said location information indicates whether said receiving party is not to be disturbed (e.g., inconvenient) (see col. 3, lines 34-38; Figs. 2 “ref. 206” and 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell and Wang to have the feature wherein said notification system being still further configured to send an alert signal to said receiving handheld device if the message is indicated as urgent by the sending party, in order to filter incoming call, such that mobile calls are not established during a time which is inconvenient for the called mobile subscriber unless the call is an emergency call, as taught by Wang (see col. 1, lines 22-25, 28-29).

Regarding **claim 9**, Rignell discloses a machine readable storage having stored thereon, a computer program having a plurality of code sections, said code sections executable by a machine for causing the machine to perform (see abstract; col. 3, lines 28-50; col. 5, lines 5-21; col. 7, line 6-25; Figs. 1-3) the steps of:



identifying an attempt to send a mobile message (call) from a sending party (A) to a receiving handheld device (C) of a receiving party (see col. 5, lines 5-21);

responsive to said identifying step, determining information local to said receiving party (C) (see col. 5, lines 15-19; Fig. 3), where the local information is the time and time zone of the receiving handheld device,

wherein said location information indicates whether said receiving party (B) is not to be disturbed (see col. 7, lines 15-18,21-25; col. 8, lines 5-8,16-20), where the message for subscriber (B) indicates a filter is active in which the “not to be disturbed” would be inherent to provide restriction of a call during a certain time range as evidenced by the fact that one of ordinary skill in the art would clearly recognized;

providing said determined local information to said sending party (A) (see col. 5, lines 15-19; col. 7, lines 6-25; col. 4, lines 60-64; col. 2, lines 28-31; col. 6, lines 64-67; Fig. 3), where the calling subscriber (A) receives local information (e.g., time zone and local time) of receiving party (C). Rignell does not specifically disclose having the feature sending an alert signal to said receiving handheld device if the message is indicated as urgent by the sending party. However, the examiner maintains that the feature sending an alert signal to said receiving handheld device if the message is indicated as urgent by the sending party was well known in the art, as taught by Wang.

In the same field of endeavor, Wang discloses the feature sending an alert signal (e.g., call) to said receiving handheld device (MS B) if the message is indicated as urgent by the sending party (MS A) (see col. 3, lines 38-49; Fig. 2 “ref. 207-210”), where the emergency call is connected to mobile subscriber unit (B). As a note, Wang further discloses the feature

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wherein said location information indicates whether said receiving party is not to be disturbed (e.g., inconvenient) (see col. 3, lines 34-38; Figs. 2 “ref. 206” and 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell and Wang to have the feature sending an alert signal to said receiving handheld device if the message is indicated as urgent by the sending party, in order to filter incoming call, such that mobile calls are not established during a time which is inconvenient for the called mobile subscriber unless the call is an emergency call, as taught by Wang (see col. 1, lines 22-25,28-29).

Regarding **claim 10**, the combination of Rignell and Wang discloses everything claimed, as applied above (see claim 9), in addition Rignell further discloses the machine readable storage according to claim 9, wherein said local information further comprises information selected from the group consisting of a time, date, and day where said receiving handheld device (C) is located (see col. 5, lines 15-19; col. 7, lines 15-18; Figs. 1-4), where the local information is the local time of day and the time zone that the receiving handheld device is located.

Regarding **claim 12**, Rignell discloses a machine readable storage having stored thereon, a computer program having a plurality of code sections, said code sections executable by a machine for causing the machine to perform (see abstract; col. 3, lines 28-50; col. 5, lines 5-21; col. 7, lines 6-25; Figs. 1-3) the steps of:

initiating a mobile message (call) between a sending party (A) and a receiving handheld device (B) of a receiving party (see col. 7, lines 6-25; Fig. 3);

receiving local information from a service provider which services said receiving handheld device (B) (see col. 7, lines 15-18; col. 4, lines 60-64), where the local information is provided in which the service provider would be obvious,

wherein said location information indicates whether said receiving party (B) is not to be disturbed (see col. 7, lines 15-18,21-25; col. 8, lines 5-8,16-20), where the message for subscriber (B) indicates a filter is active in which the “not to be disturbed” would be inherent to provide restriction of a call during a certain time range as evidenced by the fact that one of ordinary skill in the art would clearly recognized;

processing said mobile message (call) based on said received local information (see col. 7, lines 6-25; col. 5, lines 15-19; col. 4, lines 60-64; col. 2, lines 28-31; col. 6, lines 64-67; Fig. 3), where the call would be processed by the calling subscriber according to the local information of the called subscriber. Rignell does not specifically disclose having the feature sending an alert signal to said receiving handheld device if the message is indicated as urgent by the sending party. However, the examiner maintains that the feature sending an alert signal to said receiving handheld device if the message is indicated as urgent by the sending party was well known in the art, as taught by Wang.

In the same field of endeavor, Wang discloses the feature sending an alert signal (e.g., call) to said receiving handheld device (MS B) if the message is indicated as urgent by the sending party (MS A) (see col. 3, lines 38-49; Fig. 2 “ref. 207-210”), where the emergency call is connected to mobile subscriber unit (B). As a note, Wang further discloses the feature wherein said location information indicates whether said receiving party is not to be disturbed (e.g., inconvenient) (see col. 3, lines 34-38; Figs. 2 “ref. 206” and 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell and Wang to have the feature sending an alert signal to said receiving handheld device if the message is indicated as urgent by the sending party, in order to filter incoming call, such that mobile calls are not established during a time which is inconvenient for the called mobile subscriber unless the call is an emergency call, as taught by Wang (see col. 1, lines 22-25, 28-29).

Regarding **claim 13**, the combination of Rignell and Wang discloses everything claimed, as applied above (see claim 12), in addition Rignell further discloses the machine readable storage according to claim 12, wherein said local information further comprises information selected from the group consisting of a time, date, and day where said receiving handheld device (B) is located (see col. 7, lines 15-18; col. 5, lines 15-19; col. 4, lines 60-64; Figs. 1-4), where the local information is the local time of day and the time zone that the receiving handheld device is located.

Regarding **claim 15**, the combination of Rignell and Wang discloses everything claimed, as applied above (see claim 12), in addition Rignell further discloses the machine readable storage according to 12, wherein said processing step comprises, selecting an action from the group of actions consisting of sending said mobile message (call) to said receiving handheld device (B), sending said mobile message (call) to a mail box (e.g., answering machine), and not sending said mobile message (call) (see col. 7, lines 18-25; col. 8, lines 23-25), where the calling subscriber can confirm the call by deciding to connect or terminate or be connected to an answering machine or answering service.

Regarding **claim 16**, Rignell discloses a method for providing subscriber which reads on the claimed “call recipient” local information (see abstract; col. 3, lines 28-50; Figs. 1-3) comprising the steps of:

identifying an attempt to establish a call which reads on the claimed “telephone call” between a calling party (A) and a receiving handheld terminal (C) which reads on the claimed “device” of a called party (e.g., subscriber C) (see col. 5, lines 5-21);

responsive to said identifying step, determining information local to said receiving handheld device (C) (see col. 5, lines 15-19; col. 4, lines 60-64; Fig. 3), where the local information is the time and time zone of the receiving handheld device,

wherein said location information indicates whether said receiving party (C) is not to be disturbed (see col. 7, lines 15-18,21-25; col. 8, lines 5-8,16-20), where the message for subscriber (C) indicates a filter is active in which the “not to be disturbed” would be inherent to provide restriction of a call during a certain time range as evidenced by the fact that one of ordinary skill in the art would clearly recognized;

automatically determining whether to complete said telephone call or terminate said telephone call based upon said determined local information, wherein the local information includes a time and at least one of a date, day and location (e.g., Time Zone 2 or geographic area) where the receiving handheld device (C) is located (see col. 5, lines 15-19; col. 4, lines 60-64; col. 2, lines 28-31; col. 6, lines 64-67; col. 7, lines 56-64,41-49; Figs. 1-4), where the calling subscriber can confirm or decide whether to complete the connection or discontinue. Also, calls from a subscriber in a non-restricted time are connected in which the automatic determining would be inherent to allow calls such as from the same time zone, important

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calls, or non-restricted time to be connected as evidenced by the fact that one of ordinary skill in the art would clearly recognized. Rignell does not specifically disclose having the feature sending an alert signal to said receiving handheld device if the message is indicated as urgent by the sending party, said alert signal identifying said calling party. However, the examiner maintains that the feature sending an alert signal to said receiving handheld device if the message is indicated as urgent by the sending party, said alert signal identifying said calling party was well known in the art, as taught by Wang.

In the same field of endeavor, Wang discloses the feature sending an alert signal (e.g., call) to said receiving handheld device (MS B) if the message is indicated as urgent by the sending party (MS A), said alert signal identifying said calling party (see col. 3, lines 38-49; Fig. 2 “ref. 207-210”), where the emergency call is connected to mobile subscriber unit (B). As a note, Wang further discloses the feature wherein said location information indicates whether said receiving party is not to be disturbed (e.g., inconvenient) (see col. 3, lines 34-38; Figs. 2 “ref. 206” and 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell and Wang to have the feature sending an alert signal to said receiving handheld device if the message is indicated as urgent by the sending party, said alert signal identifying said calling party, in order to filter incoming call, such that mobile calls are not established during a time which is inconvenient for the called mobile subscriber unless the call is an emergency call, as taught by Wang (see col. 1, lines 22-25,28-29).

Regarding **claim 17**, the combination of Rignell and Wang discloses everything claimed, as applied above (see claim 16), in addition Rignell further discloses the method of claim 16, wherein the local information includes a time and two of a date, day, and location (e.g., Time Zone 2 or geographic area) where said receiving device is located (see col. 5, lines 15-19; col. 2, lines 28-31; col. 6, lines 64-67; col. 4, lines 60-64; Figs. 1-4), where the local information includes the local time of day and the time zone that the receiving handheld device is located in which the date would be inherent which is due to the location and/or time zone of the calling device relative to location of receiving device based on the 24 longitudinal divisions (i.e., time zones) for time keeping of the earth.

Regarding **claim 18**, the combination of Rignell and Wang discloses everything claimed, as applied above (see claim 16), in addition Rignell further discloses the method of claim 16, wherein the local information includes a time, a date, a day, and location (e.g., Time Zone 2 or geographic area) where said receiving device is located (see col. 5, lines 15-19; col. 2, lines 28-31; col. 6, lines 64-67; Figs. 1-4), where the local information includes the local time of day and the time zone that the receiving handheld device is located in which the date would be inherent which is due to the location and/or time zone of the calling device relative to location of receiving device based on the 24 longitudinal divisions (i.e., time zones) for time keeping of the earth.

Regarding **claim 20**, the combination of Rignell and Wang discloses everything claimed, as applied above (see claim 16), in addition Rignell further discloses the method of claim 16, the local information includes a location (e.g., Time Zone 2 or geographic area) where said receiving device is located (see col. 5, lines 15-19; col. 2, lines 28-31; col. 6, lines

64-67; col. 7, lines 11-18; Figs. 1-4), where the calling device is informed of the time zone of a receiving device. Time zone is the geographic location or region the receiving device is located in relative to the location of the calling device which is based on the 24 longitudinal divisions (i.e., time zones) for time keeping of the earth.

**Claims 3, 6, 11, and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rignell et al.** (hereinafter **Rignell**) (**US 5,818,920**) in view of **Wang et al.** (hereinafter **Wang**) (**US 6,934,543 B2**) as applied to claims 2, 4, 9, and 12 above, and further in view of **Labban** (**US 6,574,486 B1**).

Regarding **claim 3**, the combination of **Rignell** and **Wang** discloses everything claimed as applied above in claim 16. The combination of **Rignell** and **Wang** does not specifically disclose the feature wherein said mobile message is a text message. However, the examiner maintains that the feature wherein said mobile message is a text message was well known in the art, as taught by **Labban**.

In the same field of endeavor, **Labban** discloses the feature wherein said mobile message is a text message (see col. 3, lines 53-59; col. 6, lines 36-39; col. 7, lines 48-62; Figs. 4 “ref. 426”, 6 “ref. 624”), where the wireless telephone is capable of multiple types of calls possible, including a non-voice message type such as SMS.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of **Rignell**, **Wang**, and **Labban** to have the feature wherein said mobile message is a text message, in order to facilitate the ease of use of



a cellular telephone by displaying to the user a menu of calling options, as taught by Labban (see col. 2, lines 19-26).

Regarding **claim 6**, the combination of Rignell and Wang discloses everything claimed as applied above in claim 4. The combination of Rignell and Wang does not specifically disclose the feature wherein said mobile message is a text message. However, the examiner maintains that the feature wherein said mobile message is a text message was well known in the art, as taught by Labban.

Labban further discloses the feature wherein said mobile message is a text message (see col. 3, lines 53-59; col. 6, lines 36-39; col. 7, lines 48-62; Figs. 4 “ref. 426”, 6 “ref. 624”), where the wireless telephone is capable of multiple types of calls possible, including a non-voice message type such as SMS.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell, Wang, and Labban to have the feature wherein said mobile message is a text message, in order to facilitate the ease of use of a cellular telephone by displaying to the user a menu of calling options, as taught by Labban (see col. 2, lines 19-26).

Regarding **claim 11**, the combination of Rignell and Wang discloses everything claimed as applied above in claim 9. The combination of Rignell and Wang does not specifically disclose the feature wherein said mobile message is a text message. However, the examiner maintains that the feature wherein said mobile message is a text message was well known in the art, as taught by Labban.

Labban further discloses the feature wherein said mobile message is a text message (see col. 3, lines 53-59; col. 6, lines 36-39; col. 7, lines 48-62; Figs. 4 “ref. 426”, 6 “ref. 624”), where the wireless telephone is capable of multiple types of calls possible, including a non-voice message type such as SMS.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell, Wang, and Labban to have the feature wherein said mobile message is a text message, in order to facilitate the ease of use of a cellular telephone by displaying to the user a menu of calling options, as taught by Labban (see col. 2, lines 19-26).

Regarding **claim 14**, the combination of Rignell and Wang discloses everything claimed as applied above in claim 12. The combination of Rignell and Wang does not specifically disclose the feature wherein said mobile message is a text message. However, the examiner maintains that the feature wherein said mobile message is a text message was well known in the art, as taught by Labban.

Labban further discloses the feature wherein said mobile message is a text message (see col. 3, lines 53-59; col. 6, lines 36-39; col. 7, lines 48-62; Figs. 4 “ref. 426”, 6 “ref. 624”), where the wireless telephone is capable of multiple types of calls possible, including a non-voice message type such as SMS.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell, Wang, and Labban to have the feature wherein said mobile message is a text message, in order to facilitate the ease of use of

a cellular telephone by displaying to the user a menu of calling options, as taught by Labban (see col. 2, lines 19-26).

**Claim 19** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Rignell et al.** (hereinafter Rignell) (US 5,818,920) in view of **Wang et al.** (hereinafter Wang) (US 6,934,543 B2) as applied to claim 16 above, and further in view of **Moon et al.** (hereinafter Moon) (US 6,075,992).

Regarding **claim 19**, the combination of Rignell and Wang discloses everything claimed, as applied above (see claim 16), in addition Rignell further discloses the method of claim 16, further comprising the step of: based on the local information, deferring said telephone call (see col. 8, lines 23-25; col. 7, lines 18-25), where the calling subscriber can deferred such as being directed to an answering machine. The combination of Rignell and Wang does not specifically disclose having the feature which results in placing the call at an appropriate time as defined by at least one the calling party and the called party. However, the examiner maintains that the feature which results in placing the call at an appropriate time as defined by at least one the calling party and the called party was well known in the art, as taught by Moon.

In the same field of endeavor, Moon discloses the feature which results in placing the call at an appropriate time as defined by at least one the calling party and the called party (see col. 5, line 18 - col. 6, line 7; col. 7, lines 4-9; Figs. 1, 7), where the portable intelligent communications device (10) can automatically place a call by scheduling the call according to time ranges.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell and Moon to have the feature which results in placing the call at an appropriate time as defined by at least one the calling party and the called party, in order to automatically initiate a call to a recipient depending on the local time of such recipient, as taught by (see col. 1, lines 63-64; col. 2, lines 9-12).

*Response to Arguments*

16. Applicant's arguments filed 31 October 2006 have been fully considered but they are not persuasive.

The Examiner respectfully disagrees with applicant's arguments as the applied reference(s) provide more than adequate support and to further clarify (see the above claims and comments in this section).

17. In response to applicant's remark of claim 16 on pg. 7, 3<sup>rd</sup> ¶, "...fully supported...different portion...Fig. 2 and specification, pg. 10, ln. 12-21 and pg. 11, ln. 1-13...", the Examiner respectfully disagrees. As cited by applicant, Fig. 2 "ref. 225" clearly indicates that the originating PCD (105) selects an action (225) of a provided prompt (220). Therefore, as addressed in **item 11a** above, the claimed limitation "...**automatically**..." is clearly described as a manual selection (225) of a provided prompt (220).

18. In response to applicant's remark of claim 16 on pg. 7, 3<sup>rd</sup> ¶, "...fully supported...different portion...Fig. 2 and specification, pg. 10, ln. 12-21 and pg. 11, ln. 1-13...", the Examiner respectfully disagrees. As cited by applicant, Fig. 2 "ref. 230" clearly indicates that an alert if urgent (230) is provided via the service provider (135) in which the alert signal is a **ringtone** (see pg. 11, lines 5-8). Therefore, as addressed in **item 11b** above, the claimed limitation "...**identifying** said calling party..." is clearly described as a ringtone **not** an identification of calling party (or caller ID).

*Conclusion*

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Willie J. Daniel, Jr. whose telephone number is (571) 272-7907. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information

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for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/WJD,JR/

WJD,JR  
29 December 2006



ERIKA A. GARY  
PRIMARY EXAMINER